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09/973,729	10/11/2001	Hideki Kinugawa	214782US2X	6059

  

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314		

  

EXAMINER	
RUHL, DENNIS WILLIAM	

  

ART UNIT	PAPER NUMBER
3629	

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	02/22/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 02/22/2007.

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# Office Action Summary

Application No.

09/973,729

Applicant(s)

KINUGAWA ET AL.

Examiner

Dennis Ruhl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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Applicant's amendment of 11/22/06 has been entered. The examiner will address applicant's remarks at the end of this office action.

1. Claim 1 is objected to because of the following informalities: The language "point number each renter" reads poorly. This should read "point number to each renter".

Appropriate correction is required.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1,2,4,6,8-12, are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for calculating points when the operating time (used time or load ratio) is less than the standard time (standard used time or standard load ratio), the specification does not reasonably provide enablement for calculating points regardless of whether or not the operating time (used time or load ratio) is less than standard time (standard used time or standard load ratio), which is in the scope of the independent claims. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims. In the event that the operating time is more than the standard time, how are the points calculated? This is not clear because the only equation disclosed in the specification relates to the situation where the operating

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time is less than the standard time. One of skill in the art would not know how to go about calculating points when the operating time is more than the standard time, which is within the scope of the claims. Because one of skill in the art would have no idea how to go about calculating the points in the situation where the operating time (used time or load ratio) is more than the standard time (standard used time or standard load ratio), the examiner concludes that undue experimentation would be required. The added language to the claims of "related to a reduced consumption of the useful life of the construction machine" is not seen as overcoming this issue and applicant has not explained how and why they believe that the language overcomes the 112,1<sup>st</sup> rejection.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-8,11,12, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 1,5,8, the preamble recites that the invention is a method "of renting a construction machine"; however, the body of the claim makes no mention of any renting step. It is not clear as to what the scope of the claims are. If the method is a method of renting a construction machine, then where is the step of actually renting the machine? The steps recited in the body of the claim all take place after the machine has been rented, so it is not clear as to whether or not the claim is a method of renting or if the

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method has a scope that does not even include the actual renting of the construction machine. This is not clear.

For claims 3,5,7, what does the language "in proportion to a value obtained by" mean? The examiner is not clear as to what this means. Also, claim 3 is reciting that the evaluation standard is used to calculate a point number only in a case when the operating time (or load ratio, etc.) is less than the standard operating time. This language seems to contradict claim 1, which states that a point number is calculated, with no conditions being set forth. Is the point number being calculated like claim 1 recites, or is it only calculated when the condition set forth in claim 3 occurs? The scope of the claim is not clear.

For claim 11, it is not clear as to how many construction machines are in the scope of this claim. Line 3 recites "one or more construction machines" whereas lines 8-9 recite "said construction machine". Is there one or more or just one? This is not clear.

For claim 12 the scope of the claim is not clear. This is because applicant has claimed a receiving device "communicable" with information control means. This portion of the claim is not positively reciting the information control means as being part of the claimed terminal, it is just reciting the fact that the receiving device can communicate with the information control means. Then later in the claim applicant goes on to recite structure to the information control means. It is not clear if the information control means is being positively claimed as part of the scope of the claim.

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6. Claims 1,2,4,6,8-12, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hideki (EP 0989525A2) in view of the article "Budget Aims for Hole in One With Innovative New Frequent Renter Program Linked to Callaway Golf Company".

For claims 1,2,4,6,9,11,12, Hideki discloses a system and method for the renting of construction machines with special specifications. The individual construction machines have the ability to store information relating to the use of the construction machine (operating time, fuel consumption [claimed as load ratio], etc.). See page 4, line 57 to page 5, line 6. The information control means is considered to be 20, which is a management apparatus that receives the operating information from the construction machines. Not disclosed is that a point number is calculated based on an evaluation standard as claimed. The examiner interprets this language to be reciting a point number as is used in customer loyalty programs as will be explained. With respect to the language reciting that the point number is "*related to a reduced consumption of the useful life of the construction machine..*", this language has been considered but is not found to be claiming anything other than the calculation of a point number. This language is descriptive about the point number but adds nothing further to the calculation of a point number. The examiner does not feel that this language requires anything special about the point number. The Budget article discloses that the Budget vehicle rental company started a customer awards program that awards members with one point for each dollar spent. This is done so that the customer is enticed to do business with Budget and is more or less a marketing tool. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the

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construction machine rental system and method of Hideki with a customer awards program that awards customers points based on the amount of business they do with the construction machine rental company (which is inherently and directly related to the use and consumption of the useful life of the construction machine) and to present the total number of points to the renters so that they know how many they have earned. The claimed "evaluation standard" is the standard that 1 point is awarded for every dollar spent. That is an evaluation standard to controls how the points are awarded. The amount of money that one spends on a rental is converted to points. The amount of money is directly related to the usage of the construction machine because the rental amount is based on the usage of the machine and the time it is rented, so the point number is related to a consumption of the useful life of the construction machine because it is based on the rental fees.

For claims 8,10, Hideki discloses a system and method for the renting of construction machines with special specifications. The individual construction machines have the ability to store information relating to the use of the construction machine (operating time, fuel consumption [claimed as load ratio], etc.). See page 4, line 57 to page 5, line 6. The information control means is considered to be 20, which is a management apparatus that receives the operating information from the construction machines. Not disclosed is that a point number is calculated based on an evaluation standard. Also not claimed is that the point number is adjusted according to a stock state of available construction machines for rent. The examiner interprets this language to be reciting a point number as is used in customer loyalty programs. The Budget

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article discloses that the Budget vehicle rental company started a customer awards program that awards members with one point for each dollar spent. This is done so that the customer is enticed to do business with Budget and is more or less a marketing tool. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the construction machine rental system and method of Hideki with a customer awards program that awards customers points based on the amount of business they do with the construction machine rental company and to present the total number of points to the renters so that they know how many they have earned. The claimed "evaluation standard" is the standard that 1 point is awarded for every dollar spent. That is an evaluation standard to controls how the points are awarded. The amount of money that one spends on a rental is converted to points. With respect to the adjusting of the point number based on a stock state of available construction machines, the examiner views this limitation as adjusting the point numbers based on supply and demand for construction machines. The law of supply and demand in economics is very well known by one of ordinary skill in the art. The examiner sees the limitation of the adjusting of the point number calculated by the evaluation standard to be related to the supply and demand for the machines. When available supply is high and the rental owner wants to rent idle construction machines, one of ordinary skill in the art would recognize that you need to make the rental more attractive to the customers to get them to rent with you (i.e. a more generous points calculation). It would have been obvious to one of ordinary skill in the art at the time the invention was made to adjust the point number based on the supply of available construction



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machines, such as by offering more points for rentals when the supply is higher and less points for rentals when demand is lower.

7. Claim 5 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

8. Claims 3,7, would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

9. Applicant's arguments filed 11/22/06 have been fully considered but they are not persuasive.

With respect to the 112,1<sup>st</sup> rejection, the examiner does not understand why applicant feels that the rejection has been overcome by the amendment to the claims. The examiner does not agree that the word "reduced" overcomes the rejection and applicant has not explained their position in this issue. In the opinion of the examiner the claims must be limited to the situation where the operating information has a value less than a standard value, because that is the only time when the points are calculated. This is not reflected in the claims under this rejection.

With respect to the some of the 112,2<sup>nd</sup> paragraph issues, they have not been overcome and have not been addressed by applicant. The 112,2<sup>nd</sup> rejection for claims 3,5,7,11,12 have not been addressed at all by way of traversal or amendment.

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With respect to the prior art traversal, it is found to be non-persuasive. The added language reciting that the point number is "*related to a reduced consumption of the useful life of the construction machine*" is not further limiting the actual steps of calculating the point number. This part of the claims is just reciting the calculation of a point number with descriptive language describing what the number is related to. The examiner does not feel that this language requires anything special about the point number itself. A number is a number, what it is related to does not change the fact that the point number is still a number. In the prior art rejection, the points calculated are based on the money spent for the use and rental of the construction machine. The combination as set forth by the examiner has points being calculated, where the points are related to the consumption of the useful life of the machine. The amount of money spent (which is converted to points) is directly related to the usage of the construction machine because the rental amount is based on the usage of the machine and the time it is rented, so the point number is related to a consumption of the useful life of the construction machine because it is based on the rental fees.

With respect to claims 8 and 10, the only argument for patentability is based on language not found in these claims. Applicant has broadly argued that the language added to claim 1 renders the claims allowable, but this language is not found in claims 8 or 10.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'D. Ruhl', with a stylized flourish at the end.

DENNIS RUHL  
PRIMARY EXAMINER